

REMARKS

Claim Status:

Claims 1-11 are pending in the application.

Claims 1-3, 6 and 7 are amended without prejudice.

For example, the scope of claim 1 is broadened by: i) deleting some of the preamble, ii) changing the term “printing” to --providing--; and iii) changing the term “paper” to --substrate--. The scope of claim 1 is further changed by introducing some features formally recited in dependent claim 7.

Claims 2, 3, 6 and 7 are amended to even better conform to amended claim 1.

Claims 9 - 11 are newly presented.

Priority Questions:

The Examiner questioned the right of priority to, e.g., parent application No. 08/508,083. In particular, the Examiner asked about “**provided substrate printed paper** being steganographically encoded with plural-bit auxiliary data.” (The quotation is amended to reflect the current amendment to claim 1, above). See the Office Action, page 1 paragraph 1.

We respectfully refer the Examiner to, e.g., the “Use in Printing, Paper, Documents, Plastic Coated Identification Cards, and Other Material where Global Embedded Codes can be Imprinted” section, Col. 18, lines 4 – 48, of parent U.S. Patent No. 5,841,978 (July 1995). This section clearly shows various substrates being steganographically encoded with plural-bit data.

Reconsideration is requested.

Specification Questions:

The Specification is objected to because the Related Application Data section is “*required* to disclose all the continuing data for which this application is claiming priority to....” (*emphasis added*). We respectfully disagree.

Applicants are given a choice whether to claim priority in an Application Data Sheet or in the first sentences of the Specification. See, e.g., 37 CFR 1.76 (b) (5) (“Providing this information [domestic priority information] in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and § 1.78(a)(2) or § 1.78(a)(5), *and need not otherwise be made part of the specification.*”) (*emphasis added*).

A Revised Application Data sheet was used in this application to reflect the specific priority relationship.

Reconsideration is requested.

Statutory Subject Matter Rejection:

Claim 1 is rejected as being directed to non-statutory subject matter under 35 U.S.C. § 101. We traverse this rejection.

While we appreciate the Examiner’s helpful suggestion on page 4 of the Office Action, we have decided to broaden the scope of claim 1 by removing reference to the allegedly offending reference to a “computer system”. Claim 1 is also amended to recite that the application program is an “**electronic** application program to compose an electronic version of a document”. Surely, this can not be accomplished with a pencil on paper as suggested on page 4 of the Office Action.

Withdrawal of the rejection is requested.

Art-based Rejections:

Claims 1-8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,331,140 (hereafter “Stephany”). For some of the claims this rejection apparently relies on U.S. Patent No. 4,654,482 (hereafter “DeAngelis”). We respectfully traverse these rejections.

Claim 1 in view of Stephany

Claim 1 is amended without prejudice to recite some of the features formally found in claim 7. Now, the steganographically encoded plural-bit auxiliary data is substantially imperceptible to casual human inspection, but is detectable through *visible light imaging* of the document and processing of image data thereby produced.

This type of imaging is different from the UV/IR techniques used in Stephany. Indeed, Stephany would require special inks, UV/IR filters and/or special illumination. The recited combination, however, offers efficiencies because normal, ambient visible light is used for detection; indeed, no filters, special illumination or inks, or special lens are needed for this type of visible light imaging.

The Office Action also recognizes that Stephany fails to disclose storing at least some of the plural-bit auxiliary data in association with data identifying a location at which the electronic version of the document is stored. The Office Action apparently rely on DeAngelis for this feature. The undersigned has reviewed the DeAngelis patent, however, and has not located a discussion of storing at least some of the plural-bit auxiliary data in association with data *identifying a location at which the electronic version of the document is stored*. Clarification is requested if this rejection is maintained.

Claim 1 stands ready for allowance.

Claims 3, 5 and 6

The Office Action relies on DeAngelis to meet the features of claims 3, 4 and 6.

However, the undersigned does not see in DeAngelis: i) the storing of claim 1 including storing in a registry database maintained by an operating system of a computer system (claim 3); ii) the storing of claim 1 is performed by a computer system operating system (claim 5); and iii) the storing of claim 1 is performed by a printer driver employed in printing the document onto a substrate (claim 6).

Again, clarification (i.e., column and line citations) is requested if these rejections are maintained.

New Claims 9 and 10

We respectfully submit that new claims 9 and 10 are also ready for allowance.

For example, the applied art is not understood to render obvious a combination where the plural-bit auxiliary data of claim 1 is encoded such that decoding of the encoded plural-bit auxiliary data relies on a Fourier transform that produces data in which scale and rotation can be ignored.

Nor is the applied art understood to render obvious a combination where the Fourier transform of claim 9 comprises a Fourier-Mellin transform.

Remaining Claims

Favorable consideration of the remaining claims is respectfully solicited.

Conclusion:

We respectfully request a Notice of Allowance. In the meantime, the Examiner is respectfully invited to contact the undersigned if any questions remains. (Other deficiencies of the applied art need not be belabored at this time, but we reserve our right to do so if needed.)

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CUSTOMER NUMBER 23735

Phone: 503-469-4800
FAX: 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By: /Steven W. Stewart, Reg. No. 45,133/
Steven W. Stewart
Registration No. 45,133